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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/273,021

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HAROLD W. MILTON JR.

MILT.777

6459

7590

06/28/2006

HAROLD W. MILTON JR.
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EXAMINER

SHAH, SANJIV

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/273,021

Applicant(s)

MILTON, HAROLD W.

Examiner

Sanjiv D. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,10 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 10, 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to amendment filed on 3/24/2006. Claims 1, 3, 10, 19 and 20-28 remain in this application with claims 1, 19 and 20, 21 and 26 being independent. Claims 21-28 are newly added.

Applicant's amendment clarified issues regarding 112 2nd rejection and therefore 112 rejection is withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 21, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi et al. (Patent # 6,049,811) in view of Rivette et al. (Patent # 5,754,840).

Regarding claims 1, 21, 26, Petruzzi teaches a *method of preparing patent application with a computer* (See col. 2, lines 33-35, wherein a computer based patent application drafting is taught)

Storing a document template in a computer program which contains headings equivalent to "Background of invention, field of invention, description of prior art, summary of invention, Brief description of drawings, Detailed description, claims and abstract" (See col. 3, lines 13-18 and lines 26-32, wherein Petruzzi teaches storing the

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information in computer and drafting application using various sections including claims, summary, detailed description, etc.)

Storing a page break immediately before the claims heading in the computer program and before the abstract heading (See col. 8, lines 4-7, wherein Petruzzi specifically teaches inserting a page break when needed. Petruzzi also teaches accessing MPEP rules as described in col. 6, lines 10-15. MPEP rules clearly instruct presenting abstract and claims on separate pages. Therefore user would have been aware of inserting page break before particular section)

Storing a footer in the computer program for displaying the attorney file identification on every page of the application (See col. 16, lines 30-33, wherein Petruzzi teaches storing footer as claimed)

Composing by a user an independent claim in the computer program ending in a clause beginning with the words "characterized by" and reciting and isolating the patentable novelty and preceded by at least one clause reciting prior art elements to the extent necessary to support and provide antecedent basis for the "characterized by" clause (See col. 12, lines 45-53, wherein Petruzzi teaches composing independent claims with clause such as "comprising" or "comprising the steps" that have similar effect as of claimed clause of "characterized by". MPEP clearly states that claims should be drafted with necessary support and must provide for antecedent basis. Petruzzi also teaches accessing MPEP rules as described in col. 6, lines 10-15)

Composing a user claims in the computer program ultimately dependant upon the independent claim for successively more specifically defining the patentable novelty

(See col. 13, lines 14-27, wherein Petruzzi teaches the claimed invention of composing dependant claims by adding clause "further comprising". MPEP states that dependant claims further define patentable novelty. Petruzzi also teaches accessing MPEP rules as described in col. 6, lines 10-15)

Characterized by storing duplicate set of all of the claims in the computer program, and creating the description by retrieving the duplicate set of claims under the heading "Description of preferred embodiment" (See col. 15, lines 25-30, wherein Petruzzi teaches the claimed limitation of copying the claims to summary which is part of specification. Also as described in col. 16, lines 10-15, Petruzzi provides for a comparison of words in claims to detailed description and remind of missing words that provides for the basis of copying the claims in the Detailed description) *searching for each occurrence of the word "said" in the duplicate set of claims copied into the specification and replacing the word "said" with word "the" in the specification* (See col. 13, lines 50-55, wherein Petruzzi teaches replacing "said" with "the" as claimed) *editing the claims into grammatically correct sentence structure including adding verbs* (col. 5, lines 64-col. 8, lines 8, Wherein Petruzzi teaches conventional spell check and conventional editing. Grammatical check is also conventionally used in word processing. Also see col. 16, lines 28-34. Also as described above Petruzzi teaches replacing "said" with "the" as described in col. 13, lines 50-55, that in effect add verb and makes grammatically correct structure)

Petruzzi teaches a drawings section and figures section as shown in fig 3, element 80 and 140. However Petruzzi specifically fails to teach *assigning reference numerals for*

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the first time by the steps of storing the element names of the elements in the order recited in the duplicate set of claims, storing successive numbers beginning with a number above the highest Figure number to identify the respective element names, and searching for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims, replacing each respective element name with that respective element name followed by successive ones of said numbers to provide identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims and automatically shifting the reference numerals in response to changing the order of occurrence in the duplicate set of claims

In same field of endeavor, Rivette et al. does. Specifically Rivette et al. teaches *assigning reference numerals for the first time by the steps of storing the element names of the elements beginning with a number above the highest Figure number to identify the respective element names, (See col. 1, lines 59-63, col. 14, 38-41 and also see table 1, col. 7, lines 55-col. 8, lines 7) and searching for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims, (col. 14, lines 60-col. 15, lines 4) replacing each respective element name with that respective element name followed by successive ones of said numbers to provide identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims (See col. 16, lines 28-60, wherein Rivette teaches a method of allowing user to identify the reference numbers and modify the element name. Word processor locate reference number and text or element name can be inserted next to reference numbers as described in col. 16, lines 47-52. Since the reference numbers*

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are identified and modified with element name, it would also shift the reference numerals if order of occurrence changes as claimed because element name is inserted next to reference numbers and since each occurrence of element is searched based on element number as described in col. 14, lines 60-col. 15, lines 10. the sequence of elements may change or have changed. In such a situation, the reference numerals for a given element will automatically change. Therefore every occurrence of reference number will be replaced by reference element as claimed.

Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate Rivette's method of editing reference numbers with element name and comparing it with specification in the method of Petruzzi because it provides user with ease of determining whether consistent terminology exists in a document and for enabling user to easily modify the document so as to achieve consistent terminology.

Regarding claims 3, 22, Petruzzi teaches the claimed invention of storing duplicate set of claims under heading "summary" and editing the claims into grammatically correct sentence structure including changing "said" to "the". (See col. 15, lines 25-30, wherein Petruzzi teaches the claimed limitation of copying the claims to summary that is part of specification. Also see col. 13, lines 50-55, wherein Petruzzi teaches replacing "said" with "the" as claimed. Further in col. 5, lines 64-col. 8, lines 8, Wherein Petruzzi teaches conventional spell check and conventional editing. Grammatical check is also conventionally used in word processing. Also see col. 16, lines 28-34. Also as described

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above Petruzzi teaches replacing "said" with "the" as described in col. 13, lines 50-55, that in effect add verb and makes grammatically correct structure).

4. Claims 10, 19, 20, 23, 24, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petruzzi et al. (Patent # 6,049,811) in view of Rivette et al. (Patent # 5,754,840) as applied to claim 1 above, and further in view of Newman. (Patent # 5,774,883).

Regarding claims 10, 24, 25, 28, Combination of Petruzzi and Rivette teaches the claimed invention as described above with respect to claim 1. However Petruzzi and Rivette fails to teach searching and replacing reference numerals in claims and abstract within parenthesis

(). However, Newman teaches verifying the abstract and verifying that the reference numerals are within parenthesis as described in col. 13, lines 39-45. It is obvious that verification must be performed by searching reference numerals and then verifying if they are in parenthesis.

It would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate analyzing method of Newman in the method of Petruzzi and Rivette because it aids in drafting patent application according to MPEP rules.

Regarding claims 19, 20, 23 and 27, Petruzzi, Rivette and Newman teaches claimed limitations as described above with respect to claim 1 and 10. As per additional limitations Petruzzi teaches *storing figure paragraph under the heading Brief description of the drawings* (See col. 14, lines 65-67. Since Petruzzi teaches adding phrases and clauses as discussed above with respect to claim 1 above, it is obvious that one ordinary skill in the art can insert and store claim terminal paragraph because it would provide drafting as per MPEP rules).

It would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate Rivette's method of editing reference numbers with element name and comparing it with specification in the method of Petruzzi because it provides user with ease of determining whether consistent terminology exists in a document and for enabling user to easily modify the document so as to achieve consistent terminology.

Similarly, It would have been obvious for a person with ordinary skill in the art at the time the invention was made to incorporate analyzing method of Newman in the method of Petruzzi and Rivette because it aids in drafting patent application according to MPEP rules.

Response to Arguments

5. Applicant's arguments filed 3/24/2006 have been fully considered but they are not persuasive.

Applicant argues that cited references, Specifically Rivette fails to teach claimed feature of duplicating claims in to specification followed by assigning reference numerals in the

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order of occurrence of the elements in the description. Applicant further argues that the claims clearly distinguish over the references by reciting the building of an element list and assigning reference numerals in the order of first recitation of the element in the edited duplicate set of claims that build the description; and most importantly, that, should the order of the elements in the edited duplicate set of claims forming the description be changed (from the order in the original duplicated claims), the reference numerals in the element list will shift in response to the shift in the order of first recitation of the numbered elements in the description.

Examiner disagrees. Specifically applicant only distinguishes claimed invention over Rivette reference but claims are rejected under combination of Petruzzi and Rivette and further in view of Newman. Specifically duplicating claims in to specification is taught by Petruzzi as described in the body of rejection (See col. 15, lines 25-30, wherein Petruzzi teaches the claimed limitation of copying the claims to summary which is part of specification. Also as described in col. 16, lines 10-15, Petruzzi provides for a comparison of words in claims to detailed description and remind of missing words that provides for the basis of copying the claims in the Detailed description). Therefore applicant's argument is not persuasive. As per assigning reference numerals in the order of occurrence of the elements in the description and assigning reference numerals in the order of first recitation of the element in the edited duplicate set of claims that build the description, Rivette teaches (*See col. 1, lines 59-63, col. 14, 38-41 and also see table 1, col. 7, lines 55-col. 8, lines 7*) and searching for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims, (col.

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14, lines 60-col. 15, lines 4) replacing each respective element name with that respective element name followed by successive ones of said numbers to provide identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims (See col. 16, lines 28-60, wherein Rivette teaches a method of allowing user to identify the reference numbers and modify the element name. Word processor locate reference number and text or element name can be inserted next to reference numbers as described in col. 16, lines 47-52. Since the reference numbers are identified and modified with element name, it would also shift the reference numerals if order of occurrence changes as claimed because element name is inserted next to reference numbers and since each occurrence of element is searched based on element number as described in col. 14, lines 60-col. 15, lines 10. The sequence of elements may change or have changed. In such a situation, the reference numerals for a given element will automatically change. Therefore every occurrence of reference number will be replaced by reference element as claimed. Therefore combination of references teaches all claimed limitations.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjiv D. Shah whose telephone number is (571) 272-4098. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sanjiv D. Shah
Primary Examiner
Art Unit 2624

S. Shah
June 25, 2006